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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590

01/14/2003

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EXAMINER

GORDON, BRIAN R

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 01/14/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,890

Applicant(s)

BERNDT, MANFRED

Examiner

Brian R. Gordon

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-55 is/are pending in the application.
- 4a) Of the above claim(s) 31-46 and 51-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 20, 23-26, 29-31 and 47-50 is/are rejected.
- 7) ☒ Claim(s) 18, 19, 21, 22 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 October 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

2. Newly submitted claims 32-46 and 51-55 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: a method that does not require the specific or identical structure of the apparatus claims. The method does not require that the first and second supplier be an element of the microchip; therefore the first and second supplier can be any elements such as a pipette, dropper, or any other means.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-46 and 51-55 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

3. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on October 23, 2002 have been approved. A proper drawing correction

or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 101'. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

O/C
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Specification

6. The substitute specification filed October 23, 2002 has not entered.

7. The disclosure is objected to because of the following informalities (of the substitute specification): because reference character "3" has been used to designate both microchip and supply area on page 11, reference character "53" has been used to designate both recesses and counter electrodes on page 14-15, reference character "56" has been used to designate both supply device, supply equipment, and cartridge on page 15, and reference numeral "8" has been used to designate both signals on page 2 and the step 8 on page on page 11. On page 9, line 9 the word "corresponding" should be added before the word "supplier". On page 19, line 11, the word "corresponding" should be added before the word "supplier".

On page 16, line 6 is a run-on sentence. word "to" should be replaced with the word "which".

The hyperlink on page 6, line 5 should be removed from the specification.

✓

✓
OK

O/C
✓

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant fails to specifically refer to the elements the invention as the terminology (third supplier and fourth supplier) used in the claims; therefore it is unclear exactly which elements of the invention are considered to be the third supplier and fourth supplier.

The specification does not provide support for claim 25 that recites the third supplier comprises at least one substance sample and at least one substance reagent. As understood by the examiner the samples and reagents are contained in separate suppliers and are mixed after being introduced into the microchip.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 17, 20, 23-26, 29-31, 47-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 17, applicant has attempted to claim a supply element by describing the device in relevance to another device (microchip) that is not considered a part of applicant's invention. The claim is improper for the combination of the devices (supply element and microchip) must be clearly claimed to distinctly point out the novelty of the supply element. It appears as if the supply element of the instant claims can only be

used with a microchip of the structure (having a first supplier and a second supplier.....); therefore the combination of devices must be claimed.

It is unclear exactly which elements of the invention are considered to be the third supplier and fourth supplier.

As to claim 29, the word "the" should be inserted before supply equipment.

As to claim 49, it is unclear how the supply element can comprise itself. For the claim recites the supply element further comprising first and second assemblies, first assembly contains a module carrying said supply element. The first assembly actually is comprised of the module carrying the supply element.

Allowable Subject Matter

10. Claims 17-31 and 47-50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach nor fairly suggest a combination of a supply element and a microchip. In particular the prior art does not disclose the combination as claimed in claim 47, a microchip with first and second suppliers and supply element with a third supplier, wherein the supply element supplies substances (reagents and samples) to the microchip in order for mixing and reactions to occur.

Conclusion

12. In an effort to expedite the allowance of applicant's invention, the examiner placed a call to Mr. Henry Zykorie on January 8, 2003. The examiner made suggestions to amending the specification and the claims in order to allow the

apparatus claims of 17-31. Mr. Zykorie submitted new claims (47-50) which addressed the issues of claim 17. However, Mr. Zykorie declined the option of canceling or amending claims 17-31, as a result the rejection given above has been formed.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is (703) 305-0399. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7719 for regular communications and (703) 305-3014 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

brg
January 10, 2003


Jill Warden
Supervisory Patent Examiner
Technology Center 1700